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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,882	09/10/1997	SHIGEO YAMAGATA	B208-062-DIV	7670

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

08/926,882

Applicant(s)

YAMAGATA ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-44 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) 38-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/271,230.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sept. 19, 2002 has been entered.

Response to Arguments

2. Applicant's arguments filed Sept. 19, 2002 have been fully considered but they are not persuasive.

In re pages 4-8, applicants argue that neither claims 1-2 of the '984 patent nor Shimada is teaching or suggestion of that the position of superimposition on a display screen of the data of a first type depends on whether the mode is the first mode or the second mode as required by independent claim 49 because Shimada et al teaches the position of superimposition of the character video signal to be controlled is the position in the time axis and not the position on the display screen, that Shimada et al patent fails to teach or suggest that the position at which the character information is superimposed is varied according to the display mode, even when the character information is not changed as required by claim 51 because, in the presently claimed invention, it is the position on the display screen that is varied according to display mode even when the character information is not changed, and not the position on a

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time axis as taught by Shimada et al, and method claims 54-55, as amended, are patentable for the same reasons as discussed above with respect to apparatus claims 49 and 51, respectively.

In response, the examiner respectfully disagrees. Shimada et al discloses in col. 4, lines 1-21 that "When the bits of this signal are "11", for example, the channel ... a bit pattern of "11" and a character video signal is recorded in both track portions DATA 1 and DATA 2" and in col. 5, lines 16-63 that "The character video signal recorded as mentioned above is reproduced ... in its "mixing" state for the same period of tie as the duration of the superimpose command applied thereto". **The two bits of the mode select signal ("11" or "01" or "10") disclosed in col. 4, lines 1-21 of Shimada indicates the position on the display screen where the characters are displayed (character in DATA1 and DATA2, character in DATA1, and no character).** From the above messages, it is clear that Shimada et al discloses the claimed a superimposing means (col. 5, lines 16-63) that has a first mode (bit pattern of "01") in which data of a first type (DATA 1) contained in ID data is superimposed with the image information, and a second mode (bit pattern of "11") in which the data of the first type (DATA 1) and data of a second type (DATA 2) contained in the ID data are both superimposed with the image information and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at which the data of the first type is superimposed on a display screen in the second mode are different from each other (the display positions of DATA 1 in two modes should be different because the amount of data in two modes are different), as required by amended claims

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49 and 54, and of control means (col. 5, lines 16-63) for changing a superimposing position (the superimposing positions of bit pattern "11" and bit pattern "01" should be different because the amount of data of two mode are different) on a display screen of the character information superimposed by a superimposing means according to a display mode set by the setting means (bit patterns "11" and "01") and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (the positions of the character information to be displayed in both modes should be different because the amount of data of two modes are different and the character information to be displayed is not changed), as required by amended claims 51 and 55.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No.

5,719,984 in view of Shimada et al ('772) as set forth in paragraph #3 of the Final Office Action mailed March 11, 2002.

Regarding claim 49 of this application, claim 1 of U.S. Patent No. 5,719,984 cites all the claimed limitations except for providing means for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information; and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at which the data of the first type is superimposed on a display screen in the second mode different from each other.

Shimada et al teaches an apparatus for recording additional video signal having means (col. 4, lines 1-21 and col. 5, lines 16-63) for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at which the data of the first type is superimposed on a display screen in the second mode different from

each other (col. 4, lines 1-21 and col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

Regarding claim 50 of this application, claim 2 of U.S. Patent No. 5,719,984 cites wherein the data of the first type is date information.

Regarding claim 51 of this application, claim 1 of U.S. Patent No. 5,719,984 cites all the claimed limitations except for providing reading means for reading the information signal and ID information of the information signal from the recording medium; conversion for converting the ID information read out from the reading means into a character information; setting means for setting a display mode of the character information converted by the conversion means on the display device; superimposing means for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which

the character information is displayed, even when the character information is not changed.

Shimada et al teaches an apparatus for recording additional video signal having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out from the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode of the character information converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63) so that the superimposing characters and so forth in a recording mode can be simplified (col. 1, lines 42-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide claim 1 of U.S. Patent No. 5,719,984 with the capability of superimposing characters on the video signal reproduced from the recording medium as taught by Shimada et al in order to simplify superimposing characters on the video

signal in recording and reproducing modes.

Regarding claim 52, Shimada et al also discloses the claimed wherein the claimed setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

Regarding claim 53, the combination of claim 1 of U.S. Patent No. 5,719,984 and Shimada et al discloses all the features of the instant invention except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.

The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known electronic camera into claim 1 of U.S. Patent No. 5,719,984 in order to record the desired image.

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 49, 51-52 and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al ('772) as set forth in paragraph #5 of the Final Office Action mailed March 11, 2002.

Regarding claim 49, Shimada et al discloses a reproducing apparatus (Fig. 1) for reading out image information and ID data of the image information from a recording medium recorded with the image information and the ID data of the image information to output the information and the ID data thereof to a display device having means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading out the image information; means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the image information read out from the recording medium with the ID information read out from the recording medium; and output means (28 of Fig. 1, col. 5, lines 48-54) for outputting the image information and the ID information superimposed by the superimposing means to the display device; wherein said superimposing means has a first mode in which data of a first type contained in the ID data is superimposed with the image information, and a second mode in which the data of the first type and data of a second type contained in the ID data are both superimposed with the image information (col. 4, lines 1-21 and col. 5, lines 16-63); and wherein the position at which the data of the first type is superimposed on a display screen in said first mode and the position at which the data of the first type is superimposed on a display screen in the second mode different from each other (col. 4, lines 1-21 and col. 5, lines 16-63).

Regarding claim 51, Shimada discloses a reproducing apparatus (Fig. 1) for reading out information signal from a recording medium to output the signal to a display

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device having reading means (1 and 8 of Fig. 1, col. 5, lines 16-26) for reading the information signal and ID information of the information signal from the recording medium; conversion means (14 of Fig. 1, col. 4, lines 34-40) for converting the ID information read out from the reading means into a character information; setting means (15 of Fig. 1, col. 5, lines 29-45) for setting a display mode of the character information converted by the conversion means on the display device; superimposing means (20 of Fig. 1, col. 5, lines 48-63) for superimposing the information signal with the character information converted by the conversion means to output the information signal superimposed with the character information to the display device; control means (15 and 18 of Fig. 1, col. 5, lines 29-63) for changing a superimposing position on a display screen of the character information superimposed by the superimposing means according to a display mode set by the setting means; and wherein the control means vary, depending on the display mode, the position at which the character information is displayed, even when the character information is not changed (col. 5, lines 16-63).

Regarding claim 52, Shimada et al also discloses the claimed wherein the setting means sets the display mode according to a number of items contained in the ID information (col. 4, lines 1-21 and col. 5, lines 29-63).

The method claim 54 is rejected for the same reasons as discussed in the apparatus claim 49 above.

The method claim 55 is rejected for the same reasons as discussed in the apparatus claim 51 above.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al ('772) as set forth in paragraph #7 of the Final Office Action mailed March 11, 2002.

Regarding claim 50, Shimada et al discloses all the features of the instant invention (see the rejection of claim 49 above) except for providing that the common item is a date information.

Shimada et al teaches in col. 6, lines 3-9 that "according to the present invention, as described hereinabove, it becomes possible to additionally insert any of titles, subtitles, superimposed time indications, superimposed commercials, superimposed dialogues and still pictures by the technique of after-recording in a track region Sp

formed for coded audio signal".

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the date information in a track region Sp formed for coded audio signal since it merely amounts to selecting characters information.

Regarding claim 53, Shimada et al discloses all the features of the instant Invention (see the rejection of claim 51 above) except for providing that the information signal recording in the recording medium is an image taken by an electronic camera and the ID information includes a date of image-taking.


The capability of using the electronic camera to recording an image and the date of image-taking is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known electronic camera into Shimada et al's system in order to record the desired image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


THAI TRAN
PRIMARY EXAMINER